



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,412	02/14/2001	Danny Soroker	6727/01290	4685

7590

08/16/2006

S. Peter Ludwig  
Darby & Darby P.C.  
805 Third Avenue  
New York, NY 10022

EXAMINER

BAYARD, DJENANE M

ART UNIT

PAPER NUMBER

2141

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/783,412

Applicant(s)

SOROKER ET AL.

Examiner

Djenane M. Bayard

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-23, 25-34 and 36-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-23, 25-34 and 36-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 21-23, 25-34 and 36-43 have been considered but are moot in view of the new ground(s) of rejection.

### ***Drawings***

2. The drawings were received on 6/06/06. These drawings are acceptable.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 21-23, 25-26, 29-31, 34, 36-37, 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6628306 to Marchionda in view of Notes/Domino R5 Beta Feedback Forum to Calabria.

- a. As per claim 21, 22 and 23, Marchionda teaches for processing an electronic mail (e-mail) message having an attachment, comprising: receiving as input from a sender the e-mail message and the attachment for transmission to a recipient; sending the e-mail message and the attachment to the recipient; (See col. 4). However, Marchionda fails to specifically teach receiving as input from the sender an instruction indicative of whether to save the attachment on

Art Unit: 2141

a computer of the sender; and responsive to the instruction indicating not to save the attachment, saving, on the computer of the sender, the e-mail message without the attachment

Calabria teaches receiving as input from the sender an instruction indicative of whether to save the attachment on a computer of the sender; and responsive to the instruction indicating not to save the attachment, saving, on the computer of the sender, the e-mail message without the attachment (See *Calabria on the Notes/Domino forum clearly teaches "if the sender needs attachment saved with the sent copy of mail, they must choose a menu option"*). It is inherent to one with ordinary skill in the art at the time of the invention, as presented in the applicant argument dated 1/27/06, that the email message without or with the attachment will be saved on the computer of the sender).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to introduce the teaching of Calabria in the claimed invention of Marchionda in order to save lots of disk space (See message content, Calabria)

b. As per claims 25, 30 and 36, Marchionda teaches receiving the instruction as the input comprises receiving the instruction as the input at a the time of writing of the e-mail message by the sender (See col. 4).

c. As per claims 26, 31 and 37, Marchionda teaches wherein receiving the instruction as the input comprises receiving the instruction as the input at a time of sending of the e-mail message by the sender (See col. 4, lines 1-67 and col. 5, lines 1-67).

Art Unit: 2141

d. As per claims 29, 34 and 40, Marchionda in view of Calabria teaches the claimed invention as described above. Furthermore, Marchionda teaches receiving as input from the sender a designation of a first set of one or more recipients and a designation of a second set of one or more recipients, wherein sending the e-mail message and the attachment to the recipient comprises: sending the e-mail message and the attachment to the first set of one or more recipients; and sending the e-mail message without the attachment to the second set of one or more recipient (See col. 4, lines 1-67).

e. As per claims 41, 42 and 43, Marchionda in view of Calabria teaches the claimed invention as described above. However, Marchionda fails to teach wherein receiving the instruction as input from the sender comprises receiving as input from the sender the instruction indicative of whether to save the attachment in a sent items folder on the computer of the sender, and wherein saving the e-mail message without the attachment comprises saving, in the sent items folder on the computer of the sender, the e-mail message without the attachment

Calabria teaches wherein receiving the instruction as input from the sender comprises receiving as input from the sender the instruction indicative of whether to save the attachment in a sent items folder on the computer of the sender, and wherein saving the e-mail message without the attachment comprises saving, in the sent items folder on the computer of the sender, the e-mail message without the attachment (See *Calabria on the Notes/Domino forum clearly teaches "if the sender needs attachment saved with the sent copy of mail, they must choose a menu option). It is inherent to one with ordinary skill in the art at the time of the invention, as*

Art Unit: 2141

*presented in the applicant argument dated 1/27/06, that the email message without or with the attachment will be saved on the computer of the sender).*

It would have been obvious to one with ordinary skill in the art at the time the invention was made to introduce the teaching of Calabria in the claimed invention of Marchionda in order to save lots of disk space (See message content, Calabria)

5. Claims 27-28, 32-33 and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,628306 to Marchionda in view of Notes/Domino R5 Beta Feedback Forum to Calabria as applied to claims 21, 22 and 23 above, and further in view of U.S. Patent Application No. 6, 898622 to Malik.

a. As per claim 27, 32 and 38, Marchionda in view of Calabria teaches the claimed invention as described above. However, Marchionda fails to teach wherein saving the e-mail message without the attachment comprises saving, with the e-mail message, information identifying the attachment.

Malik teaches wherein saving the e-mail message without the attachment comprises saving, with the e-mail message, information identifying the attachment (See col. 4, lines 50-67 and col. 5, lines 1-4)

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein saving the e-mail message without the attachment comprises saving, with the e-mail message, information identifying the attachment as taught by Malik in the

Art Unit: 2141

claimed invention of Marchionda in view of Calabria in order to assist users to properly configure an e-mail communication of desired attachment files (See col. 2, line 10-14).

b. As per claims 28, 33 and 39, Marchionda in view of Calabria teaches the claimed invention as described above. However, Marchionda fails to teach wherein saving the e-mail message without the attachment comprises saving a name of the attachment with the e-mail message.

Malik teaches wherein saving the e-mail message without the attachment comprises saving a name of the attachment with the e-mail message (See col. 4, lines 50-67 and col. 5, lines 1-4).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein saving the e-mail message without the attachment comprises saving a name of the attachment with the e-mail message as taught by Malik in the claimed invention of Marchionda in view of Calabria in order to assist users to properly configure an e-mail communication of desired attachment files (See col. 2, line 10-14).

### *Conclusion*

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Djenane M. Bayard whose telephone number is (571) 272-3878. The examiner can normally be reached on Monday- Friday 5:30 AM- 3:00 PM..

Art Unit: 2141

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Djenane Bayard



RUPAL DHARIA  
SUPERVISORY PATENT EXAMINER